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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,648	05/14/2001	Amy J. Donnan	DON0002/US/2	8779

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EXAMINER
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SUHOL, DMITRY

ART UNIT	PAPER NUMBER
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3725

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/854,648

**Applicant(s)**

DONNAN, AMY J.

**Examiner**

Dmitry Suhol

**Art Unit**

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4 and 6-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4 and 6-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

In view of the appeal brief filed on September 30, 2004, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below. To avoid abandonment of the application, appellant must exercise one of the following two options;

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6-9 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 6, the structural features encompassed by the phrase "tear drop-shaped" can't be determined, rendering the claim indefinite.

Regarding claim 7, the structural features encompassed by the phrase “sun-shaped” can’t be determined.

Regarding claim 8, the structural features encompassed by the phrase “fire-shaped” can’t be determined, rendering the claim indefinite.

Regarding claim 9, the structural features encompassed by the phrase “ghost-shaped” can’t be determined, rendering the claim indefinite.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 13-16 and 18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In analyzing claim 1 for patent eligible subject matter, it is useful to first answer the question “What did applicant[s] invent?” In re Abele, 214 USPQ 682 (CCPA 1982). While the preamble of claim 13 characterizes the invention as a “method for exploring emotional experience...”, a careful reading of the specification reveals that the applicant’s invention can best be described as a kit which having articles which in turn create an environment conducive to the exploration of an emotional experience.

Having determined in general what the invention is, we must analyze it under the prevailing case law. The statute itself allows for the patenting of processes. However, it has been determined in many contexts that not all processes set forth patent eligible subject matter. One test that has recently been applied is whether the invention

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produces a useful, concrete, tangible result. See e.g., States Street Bank & Trust Co. v. Signature Financial Group Inc., 47 USPQ2d 1596 (Fed. Cir. 1998); AT&T Corp. v. Excel Communications Inc., 50 USPQ2d 1447 (Fed. Cir. 1999). Under that test, the invention must have practical utility, it must produce an assured result, and it must not be merely an abstraction lacking in physical substance.

In this case, the claimed invention does not produce a "concrete" result in the sense that it cannot be reasonably assured that any exploration of an emotional experience will be predictably enabled by the steps set forth. There is simply too much subjectivity involved because the process effectively relies on the state of mind of the participants rather than an objective standard. Actual exploration of an emotional experience, is completely up to the participants. The process itself is no more than an attempt and a hoped-for result.

The claimed invention does not produce a "tangible" result in the sense that it merely manipulates abstract ideas without producing a physical transformation or conversion of the subject matter expressed in the claim so as to produce a change of character or condition in some physical object. See In re Warmerdam, 31 USPQ2d 1754 (Fed. Cir. 1994); In re Schrader, 30 USPQ2d 1445 (Fed. Cir. 1994). In other words even if a user is able to explore an emotional experience, such a result is merely an abstraction lacking in substance, it is only thoughts or emotions without any physical outcome or manipulation of any physical substance and therefore do not represent a use having any real world value. The method does not produce a physical

transformation and yields no tangible result. It is thus effectively a manipulation of abstract ideas and is thus not statutory.

Claims 13-16 and 18 do not produce a useful, concrete, tangible result. The invention as disclosed and claimed does not promote the progress of the useful arts. Accordingly claims 13-16 and 18 do not define statutory subject matter.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by “What a Character” seven dwarves figurines, hereafter referred to as the “seven dwarves”. Seven dwarves discloses a plurality of figurines each one with a unique color pattern having a facial expression comprising a mouth and eyes distinctive of a particular emotion and a unique shape (see picture). The container as claimed is pointed to by “boxed weight” where the box is considered to be the container.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 6-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Hoose in view of Shaver et al. Van Hoose discloses an interactive toy containing most of the elements of the claims including, providing a plurality of playpieces (fig. 3) as required by claims 1 and 13, each playpiece symbolic of particular emotion (col. 2, lines 35-47) as required by claims 1 and 13, each playpiece comprising a unique shape with respect to the other playpieces (elements 29, 31, 33, 35, 37 and 39) as required by claims 1 and 13, providing a container comprising a storage chamber as required by claims 1 and 13 (element 23 and 45), a first playpiece generally symbolic of love (35) as required by claim 4, a second playpiece generally symbolic of sadness as required by claim 4 (33), a third playpiece generally symbolic of happiness (31) as required by claim 4, a fourth playpiece generally symbolic of fear (29) as required by claim 4, one or more playpieces comprising one or more panels enclosing a stuffing material (col. 5, lines 18-21 and fig. 3, element 35), a container being heart shaped and a plush pillow bag as required by claims 11 and 12 (elements 23 and 45). Van Hoose further discloses interacting with a toy as required by claims 13-15 (col. 3, lines 6+). Regarding the shapes required by claims 6-9, it is considered that the shapes of the play-pieces, 29, 31, 33, 35, 37 and 39, read on all the shapes required (as best understood). Furthermore, the specific shapes encompassed by claims 6-9 are an obvious design choice in that the applicant discloses no critical need or advantage for them.

Although Van Hoose discloses most of the elements of the claims, as stated above, including each playpiece having a color (col. 2, lines 36-47) the reference fails to teach each playpiece comprising a unique color as required by claims 1 and 13, each playpiece comprising a unique facial expression comprising eyes and mouth as required by claims 1 and 13, a separate playpiece generally symbolic of anger as required by claim 4, and naming an emotion corresponding to a playpiece as required by claim 16. However, Shaver discloses an interactive toy like that of Van Hoose, which teaches the use of a unique color for a plurality of playpieces generally symbolic of a particular emotion (col. 4, lines 58-59 and figs. 10a-10g) as well as a unique facial expression for demonstrating a particular emotion (col. 4, lines 43-46 and figs. 9a-9j). Shaver further teaches that it is known to have user name the emotion corresponding to a playpiece, as required by claim 16, in col. 5, lines 28-37. Therefore it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention, to incorporate the teachings of Shaver in the toy of Van Hoose for the purpose of further assisting children with recognizing emotions, thoughts and actions in daily life by providing playpieces which are distinctive in appearance from each other. It would have been further obvious to provide the toy of Van Hoose with a separate playpiece generally symbolic of anger, especially since Van Hoose recognizes anger as an emotion which needs to be displayed (col. 2, line 39) and since representation of anger as an emotion is well known in the art. It would have been further obvious to including the step of naming an emotion corresponding to a playpiece for the purpose of clearly identifying a child's emotions.



Claims 1, 4, 10, 13-15, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Solomon '521 in view of Sparks '215 and Shaver et al '778. Solomon discloses an interactive toy for exploring emotional experience containing most of the claimed elements including with reference to claims 1 and 13, providing a plurality of play-pieces (21-26) symbolic of a particular emotion (21a-26a) with a unique facial expression comprising a mouth and eyes (expressions 21a-26a) and a container (10) comprising a storage chamber (41) into which the pieces may be independently stored. Regarding claim 4, lacking any distinguishing limitations, the play-pieces being representative of various emotions including love (24a), sadness (21a), happiness (25a), anger (22a) and fear (26a) are all shown in figure 1. One or more play-pieces comprising one or more panels enclosing a stuffing material, as required by claim 10, are described in col. 2, lines 48-52. The step of interacting with the toy, as required by claims 13 and 14, is discussed in col. 2, lines 56+. Withdrawing a play-piece from the container, as required by claim 15, is inherent in the device since without such a step the device will not function as intended since the puppets will remain in container 41.

The reference fails to disclose the play-pieces having a unique color and a unique shape respective each other as required by claim 1. However, Sparks teaches the benefits of figures (like those of Solomon) to communicate feelings/emotions through the use of body language (considered different unique shapes, see figure 3 and col. 4, lines 54-58). While Shaver teaches using unique colors associated with a plurality of play-pieces to symbolize emotions/feelings (col. 4, lines 58-59 and figs. 10a-10g). Therefore it would have been obvious to manufacture the figures of Solomon with

various and unique shapes/poses and different unique colors for the purpose of further conveying different feelings and emotions, especially since Solomon clearly teaches that the figures of his invention may use color (col. 3, lines 9-10).

Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Hoose in view of Shaver et al (as stated above) and further in view of Childsworld/Childsplay "Feelings Frogs Game". Van Hoose discloses most of the elements of the claims, as stated above, but for each playpiece comprising textual information indicative of a particular emotion corresponding to a playpiece as required by claims 17-18. However, Childsworld/Childsplay discloses interactive playpieces which teach the use of a unique color and the use of textual information for a plurality of playpieces generally symbolic of a particular emotion (see Childsworld/Childsplay "Feelings Frogs Game", page 22). Therefore it would have been obvious to incorporate the teachings of Childsworld/Childsplay in the toy of Van Hoose for the purpose of further assisting children with recognizing emotions, thoughts and actions in daily life by providing playpieces which are distinctive in appearance from each other.

Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Solomon '521, Sparks '215 and Shaver et al '778, as stated above, and further in view of Childsworld/Childsplay "Feelings Frogs Game". Solomon discloses most of the elements of the claims, as stated above, but for each play-piece comprising textual information indicative of a particular emotion corresponding to a play-piece as required

by claims 17-18. However, Childswor/Childsplay discloses interactive play-pieces which teach the use of a unique color and the use of textual information for a plurality of playpieces generally symbolic of a particular emotion (see Childswor/Childsplay "Feelings Frogs Game", page 22). Therefore it would have been obvious to incorporate the teachings of Childswor/Childsplay in the toy of Van Hoose for the purpose of further assisting children with recognizing emotions, thoughts and actions in daily life by providing play-pieces which are distinctive in appearance from each other.

### ***Conclusion***

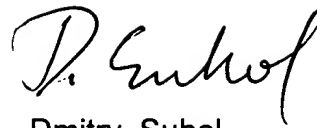
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 571-272-4430. The examiner can normally be reached on Mon - Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read "D. Suhol". The signature is fluid and cursive, with a large initial "D" and a stylized "Suhol".

Dmitry Suhol  
Examiner  
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ds